

REMARKS

REVIEW

The current application sets forth Claims 1 through 20 of which Claims 1 and 10 independent claims. Presently, no claims have been indicated as allowed in view of the prior art. Claims 11-20 stand objected to for various informalities.

Claims 4-10 and 14-20 stand rejected under 35 U.S.C. §112, second paragraph for failing to particularly point out and distinctly claim the subject matter Applicant's regard as their invention. Claims 1-7, 9, 11-17 stand collectively rejected under 35 U.S.C. §102(b) as being allegedly anticipated by *Bassett*, U.S. Patent No. 3,057,624. Claims 4-7, 9, 14-17, 19 stand collectively rejected under 35 U.S.C. §103(a) as unpatentable *Bassett* in view of *Somerville*, U.S. Patent No. 4,828,268. Claims 8 and 18 stand collectively rejected under 35 U.S.C. §103(a) as unpatentable over *Bassett* in view of *Somerville* and further in view of *Grutta*, U.S. Patent No. 2,972,833. Finally, Claims 10 and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Bassett* in view of *Somerville* and further in view of *Kleva*, U.S. Patent No. 4,431,386.

CLAIM OBJECTIONS

Examiner objected the use of "non-flexible" which appears in Claims 11 through 20 as lacking antecedent basis. Claims 11 through 20 have been amended and are now believed to be in a condition for allowance

35 U.S.C. §112, SECOND PARAGRAPH REJECTION

As to Examiner's rejection based upon the second paragraph of § 112, Applicant respectfully directs Examiner to Claims 4 and 14. Both dependent Claims 4 and 14 conclude with the limitation " wherein said grid comprises one of a Cartesian grid and a honeycomb grid formed by said delineations." This clearly restricts the claimed object to a grid that is either a Cartesian grid or a honeycomb grid, but not both. Therefore, the claim is not directed to a grid being both a Cartesian and a honeycomb grid and the language of the claim is not unclear.

35 U.S.C. §102(b) REJECTION

With respect to the 35 U.S.C. §102(b) rejection of Claims 1-7, 9, 11-17, and 19, and in view of the significant distinctions discussed herein, Applicant respectfully traverses such ground of rejection with the above amendment(s) and the following remarks.

As discussed in greater detail below, Independent Claims 1 and 11 encompass certain common aspects that distinguish them from the proposed reference. It is respectfully submitted that the reference, *Bassett*, merely serves to demonstrate the patentability of Applicant's claimed invention. Specifically, *Bassett* fails to adequately disclose every element of the claimed invention and as such cannot serve at law as an anticipating reference to the present invention under 35 U.S.C. §102.

Before setting forth a discussion of the prior art applied in the Office Action, it is respectfully submitted that controlling case law has frequently addressed rejections under 35 U.S.C. §102.

"For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed. Cir. 1988; emphasis added). The disclosed elements must be arranged as in the claim under review. See Lindemann Machinefabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). If any claim, element, or step is absent from the reference that is being relied upon, there is no anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986; emphasis added). Anticipation under 35 U.S.C. Section 102 requires that there be an identity of invention. See Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 619, 225 U.S.P.Q. 634, 637 (Fed. Cir. 1985; emphasis added). In PTO proceedings, claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 U.S.P.Q. 385, 388 (Fed. Cir. 1983). The following analysis of the present rejections is respectfully offered with guidance from the foregoing controlling case law decisions.

Independent Claims 1 and 11, as originally filed, each require that the surface of the tile be compatible with a dry marker such that marks from the dry marker upon such a surface may be easily erased. Paragraph 0029 of the application describes the tile surface as follows:

Tile surface 101 is a dry-erase surface, that is, it is compatible with the use of dry-erase markers upon it such that marks from such a dry-erase marker are non-permanent and easily erasable without resort to solvent, e.g., water or cleaning solution. Construction of dry-erase surfaces is well-known. They can be constructed by laminating a substrate with a polypropylene layer. In the alternative, a substrate, for example, one comprised of polystyrene, may be treated with a clear polymer sealant coating to provide a dry-erase compatible surface.

The term “dry-erase markers” has the commonly understood definition. In particular, the term “marker” as used in this application is defined as it is commonly understood, i.e., a marking pen. A dry-erase marker is a commonly understood generic name for the category of marking pens that deliver ink to a surface, a non-limiting example of which is what is known as “dry-erase board” or a “white board,” such that marks made by the special ink are easily erased by simply wiping them off such surface with a cloth or eraser. As set forth in Claims 1 and 11, the surface claimed must be compatible with such dry-erase markers. It is well-known that surfaces such as dry-erase boards are made by laminating or sealing a substrate to provide a non-porous surface onto which markings are made so that the ink delivered to the surface is not absorbed into the surface, but may be easily wiped off. Claims 1 and 11 have been amended to provide greater clarity.

Turning to the reference cited, *Bassett* does not disclose or suggest that the board pieces disclosed therein possess a surface upon which one could write, draw or otherwise mark with a dry-erase marker such that marks made by a dry-erase marker could be easily erased. Indeed, *Bassett* does not even suggest marking upon the surface of its board at all. In ¶ 5 of the office

action, Examiner asserts that cardboard, disclosed in *Bassett* as a material out of which a gameboard may be formed, is known to be compatible with “erasable markers.” Respectfully, Applicant counters that the term “markers” as used in this case possesses the common meaning, or that of marking pen. It is well-known that a cardboard surface is not compatible with markers, or marking pens, such that a mark upon a cardboard surface could be easily erased because cardboard is a porous surface.

Based upon the above-described distinctions and the above amendments, it is believed that Claims 1 and 11 and their respective independent claims are now in condition for allowance and acknowledgment of the same is earnestly solicited.

35 U.S.C. §103(a) REJECTIONS

In view of the above amendments and the significant distinctions discussed above, Applicant respectfully traverses such grounds of rejection. By relying on rejection grounds under 35 U.S.C. §103(a) for alleged obviousness, and by various statements throughout the detailed Office Action, the PTO already acknowledges certain important deficiencies of the base reference, *Bassett*, which renders such base reference inadequate for serving as a rejection basis by itself for any of Claims 4 through 10 and 14 through 20.

Furthermore, respect to independent Claims 1 and 11, it is respectfully submitted that *Bassett* cannot at law serve as an anticipating reference as shown above. None of the secondary references cited serve to overcome the faults of the base reference mentioned above. Therefore,

it is respectfully submitted that dependent Claims 4 through 10 and 14 through 20 are in condition for allowance.

An invention is only obvious under 35 U.S.C. §103(a) if "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (*Emphasis added*) The task of proving obviousness is not merely establishing that all of the elements of a claimed invention would have been obvious. It must be shown that the particular combination of elements used to form the whole invention would have been obvious. There must be some suggestion, incentive, or motivation to combine the elements in the manner as in the claimed invention. It is therefore, respectfully submitted that the use of *Bassett* as a basis for the 35 U.S.C. §103(a) rejection of claims 2 through 10 and 12 through 20 is improper. As such, it is believed that all of the outstanding 35 U.S.C. §103(a) rejections are improper and their withdrawal is earnestly solicited.

CITED RELEVANT PRIOR ART

It is not believed that any of the prior art cited but not relied upon, alone or in combination either with each other or other cited prior art teaches, discloses, suggests or makes obvious the claimed features of the present invention.



Attorney Docket No. 03-0431.01

CONCLUSION

In view of the foregoing amendments and comments, Applicant respectfully requests withdrawal of the current grounds of rejection and the issuance of a formal Notice of Allowance. The Examiner is invited to telephone the undersigned at his convenience should only minor issues remain after consideration of this amendment in order to permit early resolution of the same.

Respectfully submitted,
Lanier Ford Shaver & Payne, P.C.

Date 4.12.04

George P. Kobler 
Reg. No. 46,837
P.O. Box 2087
Huntsville, Alabama 35804-2087
Tel: 256.535.1100
Fax: 256.533.9322